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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,258	04/06/2005	Michael John Radley Young	1423-5 PCT US	5378
31554 7590 05/28/2008 CARTER, DELUCA, FARRELL & SCHMIDT, LLP 445 BROAD HOLLOW ROAD SUITE 225 MELVILLE, NY 11747				
EXAMINER ROZANSKI, MICHAEL T				
ART UNIT		PAPER NUMBER		
3768				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,258

Applicant(s)

YOUNG ET AL.

Examiner

MICHAEL ROZANSKI

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/15/08 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-4, 9-14, and 20-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-10, and 14-19 of US Patent No. 7,318,832 in view of Truckai et al (US 6,773,409). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than those of the '664 application. Furthermore, claim 15 of the copending application refers to generation of torsional vibrations.

The claimed first jaw member structure in '832, however, does not have a saw-like profile whereby the second jaw has a complementary shaped surface. Truckai et al teaches of a surgical system for applying ultrasonic energy including a 1st and 2nd jaw members 120A, 120B, wherein jaw element 120B has grip elements 168 (or angled cutting elements). Jaw element 120A has a surface with a structure 172a, 172b that has a complementary shape to that of the operating surface of the 1st jaw [0049-0051]. It would have been obvious to the skilled artisan to modify '832, as taught by Truckai et al, in order to provide a more reliable, effective weld of the tissue volume [0007].

Therefore, any surgical tool meeting the limitation of the '664 application would necessarily meet those of the instant application, as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze et al (US 5,669,544 –previously cited) in view of Wuchinich (US 6,984,220 – previously cited) and Truckai et al (US 6,773,409)

Schulze et al disclose a surgical instrument with a 1st jaw 842 and a 2nd jaw 832 used for performing endoscopic surgical procedures. The jaws are opened by rotating the rotation knob 820, which rotates tube 838 (i.e. carrier means), in a first direction R1 and closed by rotating in a second direction R2.

The first jaw member, however, does not have a saw-like profile whereby the second jaw has a complementary shaped surface. Truckai et al teaches of a surgical system for applying ultrasonic energy including a 1st and 2nd jaw members 120A, 120B, wherein jaw element 120B has grip elements 168 (or angled cutting elements). Jaw element 120A has a surface with a structure 172a, 172b that has a complementary shape to that of the operating surface of the 1st jaw [0049-0051]. It would have been obvious to the skilled artisan to modify Schulze et al, as taught by Truckai et al, in order to provide a more reliable, effective weld of the tissue volume [0007].

Schulze et al and Truckai et al do not teach of a tool capable of transmitting torsional ultrasonic vibrations. Wuchinich teaches an apparatus that provides simultaneous longitudinal and torsional ultrasonic vibrations for dissecting biological tissue (col 2, lines 59-64). It would have been obvious to one with ordinary skill in the

art at the time the invention was made to modify Smith et al to substitute the waveguide and end effector with a longitudinal torsional assembly, as taught by Wuchinich, because the simultaneous vibrations would allow rapid, precise removal of tissue normally resistant to ultrasonic dissection. Further, instruments that incorporate rotation into the tip (i.e. Smith et al) often require rotating seals and bearings making them complicated in construction, expensive to manufacture, and fragile in use (col 1, lines 46-54).

Response to Arguments

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

In addition, the double patenting rejection is maintained. Although the current application does not specifically claim the two protrusions as claimed in copending application 10/399,664, this limitation is not patentably distinct from the structural limitations of the current invention. Although the copending application includes a narrower limitation with regard to certain structure, this is not sufficient to recite structure than is patentably distinct from the limitations of the current invention. The amended portions of the independent claims are now met by secondary reference (Truckai et al), which teaches the additional structure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL ROZANSKI whose telephone number is (571)272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric F Winakur/
Primary Examiner, Art Unit 3768

MR